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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09 220,142	12 23 1998	STEPHEN H. FRIEND	9301-035-999	3869

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PENNIE AND EDMONDS  
1155 AVENUE OF THE AMERICAS  
NEW YORK, NY 100362711

EXAMINER
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MARSCHER, ARDIN H

ART UNIT	PAPER NUMBER
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1631

34

DATE MAILED: 08 04 2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/220,142

Applicant(s)

FRIEND ET AL.

Examiner

Ardin Marschel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 24 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4) ☐ Claim(s) 14, 18, 22, 26, 47, 50, 61, 64, 92, 96, 106, 119 and 123 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) ☐ Claim(s) 18, 26, 50, 64, 96, 106 and 123 is/are allowed.

6) ☐ Claim(s) 14, 22, 47, 61, 92 and 119 is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☒ Interview Summary (PTO-413) Paper No(s). 33.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_. 6) ☐ Other: \_\_\_\_\_

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### DETAILED ACTION

Applicants are hereby informed that the amendments, filed 12/27/02 and 7/24/03, have been approved for entry and have been entered. As noted in the Examiner Interview Summary of 7/25/03, applicants' response has overcome the previous rejections of record and therefore the Notice of Appeal, filed 12/27/02, is deemed moot. Also, the finality of the office action, mailed 6/27/02, has been withdrawn.

Applicants' arguments, filed 7/24/03, have been fully considered and they are deemed to be persuasive to overcome the previous rejections of record in a timely manner. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. Unfortunately, upon reconsideration, the following rejections and/or objections are newly applied. They constitute the complete set presently being applied to the instant application.

### DOUBLE PATENTING REJECTIONS

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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Claims 14, 22, 47, 61, 92, and 119 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 16-19 of U.S. Patent No. 6,203,987. Although the conflicting claims are not identical, they are not patentably distinct from each other because the respective sets of claims are directed to the defining, determining, or grouping of consensus or co-varying sets of cellular constituents which co-vary or are consensus cellular constituents in response to perturbations. The defining and determining characterization of the respective methods claims are reasonably equivalent. Claims 16-19 of said Patent include clustering limitations therein for forming similarity analyses for the cellular constituent responses. Such clustering is broadly cited in said Patent claims thus requiring the usage of the specification of said Patent as a Dictionary to define what is meant thereby. Clustering is defined in said Patent specification in column 10, line 47, through column 14, line 3, wherein a majority of the clustering practice is defined as being performed by the clustering "hclust" in column 11, line 63, through column 12, line 19. Thus, hclust is clearly a suggested and motivated specie of clustering within the practice of the above listed Patent claims in support of this rejection. A clearly suggested and motivated specie within a generic invention as in claims 16-19 of said Patent are deemed obvious species therein. The instant claims also are directed to hclust practice as in instant claim 14, line 12, instant claim 22, last line, etc.

It is also noted that the Patent claims are generic regarding the number of cellular constituents and corresponding profiles which are measured. Again the Patent specification is reasonably utilized as a Dictionary for what cellular profiles or

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constituents are being measured. The Patent specification at several citations indicates the profiling of such constituents as being numerous in number with several specific numbers set forth in column 8, lines 22-27, wherein "at least 5" is a clearly suggested and motivated specie. Again, a clearly suggested and motivated specie within a generic invention as in claims 16-19 of said Patent are deemed obvious species therein. The instant claims also are directed to the at least 5 response profiles practice as in instant claim 14, line 13, instant claim 22, line 11, etc.

Thus, it would have been obvious to someone of ordinary skill in the art at the time of the instant invention to practice clearly suggested and motivated species within the Patent claims 16-19 with Dictionary usage of the patent specification to result in the practice of the above listed instant claims.

Claims 18, 26, 50, 64, 96, 106, and 123 are allowed.

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CFR § 1.6(d)). The CM1 Fax Center number is either (703)308-4242 or (703)305-3014.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., whose telephone number is (703)308-3894. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (703)308-4028.

Any inquiry of a general nature or relating to the status of this application should be directed to Legal Instrument Examiner, Tina Plunkett, whose telephone number is (703)305-3524 or to the Technical Center receptionist whose telephone number is (703) 308-0196.

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August 1, 2003

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Patent Attorney  
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